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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,635	02/07/2001	Thomas J. Colson	822.000418	9591

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SIMPSON & SIMPSON, PLLC
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EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,635

Applicant(s)

COLSON ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-14 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14 and 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

HC

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 24, 2005 has been entered.

Claims 1, 11, 13, 16 18, 19, 21, 24, 26, 28 and 29 have been amended. Claims 1-4 6-14 and 16-30 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 1, 11, 13, 16 18, 19, 21, 24, 26, 28 and 29 are acknowledged.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-14 and 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over BountyQuest as disclosed on Web Archive (November 9, 2000) in view of Tropper (U.S. 2001/0034669).

As per claim 1, BountyQuest discloses a method for collecting and communicating information related to validity of a patent over a global information network, comprising:

a) soliciting bounty hunters via a global information network for prior art related to validity of said patent (pages 1-5, 10 and 14; BountyQuest solicits bounty hunters for prior art by placing bounty posting on its website. See sample posting from October 18, 2000.);

b) receiving substantive information related to said validity of said patent from at least one of said bounty hunters in response to said solicitation (pages 15 and 16; Bounty hunters submit relevant information related to a bounty posting.); and,

c) sanitizing said substantive information to remove information (page 17; When BountyQuest receives submissions of substantive information from bounty hunters, BountyQuest removes, or sanitizes, the name of the bounty hunter from the substantive information before providing the information to the bounty poster.).

BountyQuest does not expressly disclose sanitizing said substantive information to remove bibliographic information. Tropper discloses a system for finding prior art potentially having a bearing on the validity of a patent that permits a potential purchaser to review at least part of a document without being informed of the document's bibliographic data (abstract; paragraphs 20-22). By removing the bibliographic data from a document, the source of where the document is from is hidden from the potential purchaser. If the potential purchaser wants access to the bibliographic data, the potential purchaser must purchase the document. At the time of the invention, it would

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have been obvious to a person of ordinary skill in the art for BountyQuest to remove bibliographic information from the substantive information since it already has the means to remove information related to the document and further, since the potential purchaser is not informed of where the document is from and can only pay to receive such information, this ensures BountyQuest (and/or the searcher) payment for the document (Tropper, abstract), thus enhancing the effectiveness and integrity of the system.

As per claim 2, BountyQuest discloses the method of Claim 1 further comprising the step of submitting said sanitized substantive information to a bounty offeror (page 17; When BountyQuest receives information, it filters the data and keeps bounty hunters anonymous. The information is forwarded to the bounty offeror.).

As per claim 3, BountyQuest discloses the method of Claim 2 further comprising the step of paying a bounty to one of said bounty hunters a bounty when said received substantive information meets specific requirements (pages 13, 16 and 17; A bounty hunter is paid a bounty if the information meets certain requirements.).

As per claim 4, BountyQuest discloses the method of Claim 2 wherein said specific requirements are specified by said bounty offeror (pages 3-5 and 12-15; The requirements for the bounty hunter are specified by the poster. See sample posting from October 18, 2000.).

As per claim 6, BountyQuest discloses the method of Claim 1 wherein said sanitizing comprises removal of information related to identity of the third party who

submitted said substantive information (page 17; Bounty hunters' names are kept anonymous when their submissions are reviewed and possibly made public.).

As per claim 7, BountyQuest discloses the method of Claim 1 further comprising the step of time-stamping submissions of bounty hunters in response to said solicitation to determine chronological order of receipt (pages 16 and 17; An "official" time of submission is established for each entry.).

As per claim 8, BountyQuest discloses the method of Claim 1 further comprising the step of comparing at least two submissions of substantive information received in response to said solicitation to determine if substantive information received from one of said bounty hunters differs from substantive information received from another of said bounty hunters (pages 13, 16 and 17; If multiple submissions are received, they are compared for the time they are received and for the substance of the information.).

As per claim 9, BountyQuest discloses the method of Claim 8 further comprising the step of submitting a plurality of sanitized substantive information disclosures to a bounty offeror when said comparison indicates that different substantive information has been received from at least two of said bounty hunters (pages 13, 16 and 17; When multiple submissions are received from different bounty hunters, the submissions are compared for the time they are received and for the substance of the information. If the bounty poster is already aware of a reference submitted, additional submissions are allowed to determine a winner.).

As per claim 10, BountyQuest discloses the method of Claim 9 further comprising the step of paying a bounty to at least one of said bounty hunters when certain

requirements are met (pages 13, 16 and 17; A bounty hunter is paid a bounty if the information meets certain requirements.).

Claims 11-14 and 16-30 recite substantially similar limitations to claims 1-4 and 6-10 above. Therefore, claims 11-14 and 16-30 are rejected on the same basis as claims 1-4 and 6-10 above.

Response to Arguments

5. Applicant's arguments are moot in view of the new grounds of rejections.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bhimani et al. (U.S. 6,807,569) discusses a system for anonymously sharing information; and
- "BountyQuest Launches First Internet Destination Offering Large Cash Rewards For Vital Information; Bounties Starting at \$10,000 Will Help Settle High-Stakes Patent Disputes; Site Backers Include Jeff Bezos and Tim O'Reilly," PR Newswire, Oct 18, 2000 [retrieved from Dialog] discusses the features of BountyQuest.com.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to:

703-872-9306	[Official Communications; including After Final communications labeled "Box AF"]
571-273-6727	[For status inquiries, draft communication, labeled "Proposed" or "Draft"]

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Hand delivered responses should be brought to:

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June 8, 2005

Susanna Diaz

**SUSANNA M. DIAZ
PRIMARY EXAMINER**

AU3623